

Appl. No. 10/608,005  
Amendment dated: March 21, 2005  
Reply to OA of: October 21, 2004

### **REMARKS**

Applicant has amended the specification and claims to more particularly define the invention taking into consideration the outstanding Official Action.

The specification has been amended at page 2 to refer to the U.S. Patent 6,503,542 instead of the corresponding serial number as required by the Examiner in the Official Action. Accordingly, the objection to the specification has been obviated and it is most respectfully requested that this objection be withdrawn.

Claims 1, 3, 9, 15 and 19 have been amended and claims 2, 7, 13-14 and 20 have been canceled without prejudice or disclaimer in an effort to expedite the prosecution to an early allowance. The Examiner's helpful comments are appreciated. As recognized in the Official Action, some alcohol must be used in the extraction process. Therefore, as correctly noted by the Examiner in the Official Action, some alcohol must be present and the claim cannot read on 0% alcohol. Therefore, the claims have been amended to positively recite that alcohol is present. This amendment is fully supported by the specification as interpreted by the Examiner and as would be appreciated by one of ordinary skill in the art to which the invention pertains. Accordingly, it is most respectfully requested that this aspect of the rejection be withdrawn.

In addition, the limitations from claims 2 and 7 have been incorporated into claim 1, claim 14 has been incorporated into claim 9 and claim 20 has been incorporated into claim 15 thereby obviating this aspect of the rejection.

Applicant most respectfully submits that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

The rejection of claims 1-6, 8-13 and 15-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention has been carefully considered but is respectfully traversed in view of the amendments to the claims. Please also note that claim 15 provides for an extract in the second indented paragraph. Accordingly, it is believed that this rejection has been obviated and therefore it is most respectfully requested that this rejection be withdrawn.

The rejection of claims 1, 2 and 6 under 35 U.S.C. §102(b) as being anticipated by Huo et al. has been carefully considered but is most respectfully traversed.

Applicant wishes to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

*Akzo N.V. v. International Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) (Claims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.).

Accordingly, it is most respectfully requested that this rejection be withdrawn in view of the amendments to the claims and the discussion below.

The rejection of claims 1-20 under 35 U.S.C. 103 as unpatentable over Huo et al., Liang et al. or Chen in view of Chang has been carefully considered but is most respectfully traversed in view of the amendments to the claims and the following comments.

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Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence present by applicant and the citation of In re Soni for error in not considering evidence presented in the specification.

The pharmaceutical composition of the present invention is not disclosed in the cited Huo et al., Liang et al., Chen or Chang. The dietary supplement of Huo et al. is applied for the treatment of non-insulin dependent diabetes mellitus which comprises the following plant components: Radix ginseng, Radix rehmanniae, Radix ophiopogonis, Fructus schisandrae, Rhizoma dioscoreae, Radix astragali, Radix trichosanthis, Radix puerariae, Fructus lycii, Sclerotium poria cocos, Rhizoma alismatis, Rhizome coptidis,

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Fructus rubi, Radix scutellariae, and Radix glycyrrhizae; which is totally different from the effect of pharmaceutical composition of the present invention; mainly applied for treating allergic asthma.

The suppository of the Liang et al. reference is applied for treating human ailments comprises at least one herb and a suppository vehicle; the cited Chen reference includes composition and methods of treating and preventing prostate and urinary problems in male human; to sum up the information above the present invention is provided with both different compositions and medical functions which are not disclosed or in the cited references of Huo et al., Liang et al., Chen or Chang. Therefore, the presently claimed invention is both novel and non-obvious and surely is patentable. Accordingly, it is most respectfully requested that this objection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

BACON & THOMAS, PLLC

By:   
Richard E. Fichter  
Registration No. 26,382

625 Slaters Lane, 4<sup>th</sup> Fl.  
Alexandria, Virginia 22314  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080  
REF:kdd  
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